

Appl. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

REMARKS

Reconsideration is respectfully requested.

Claims 8 through 22 and 24 through 33 have been cancelled from the application.

No claims are currently withdrawn.

Claims 34 through 45 have been added to the application by this Amendment.

Therefore, claims 1 through 6, 23 and 34 through 45 are pending in this application.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 6 of the Office Action

The drawings have been objected to as not showing the "software" element mentioned in the specification at page 7, line2.

The specification states at page 7, line 2 that "[t]he hardware and software [is] depicted in Fig. 1", and this statement has been amended above to remove the explicit statement that the software is "depicted" in Figure 1. It is submitted that one of ordinary skill in the art recognizes that "software" is typically not a distinct physical element in an apparatus, and is resident in memory and storage devices such as, for example, storage device 135 which is depicted in Figure 1.

Withdrawal of the objection to the drawings is respectfully requested.

Paragraphs 7 through 10 of the Office Action

Claim 23 has been rejected under 35 USC 112 (second paragraph) as being indefinite.

As to paragraph 9, the rejection states that "[t]he specification recites

Appn. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

that the controller 117 performs all of the means plus function limitations". It is presumed that the controller "171" is intended by this statement. It is further stated in the rejection that "the controller without instructions would not perform anything". However, it is noted that the specification states at page 8, lines 14 through 17, that:

In an embodiment, the controller 171 includes instructions capable of executing on a processor (not shown) to perform functions, as further described below with respect to Fig. 3. In another embodiment the controller 171 may be implemented in hardware.

It is therefore submitted that the specification does disclose "instructions", so the basis for the rejection is not clear. If the rejection is maintained in light of the foregoing, the Examiner is respectfully requested to explain how this is insufficient.

Further, it is submitted that one of ordinary skill in the art recognizes that the functions of the controller may be performed by, for example, hardware or software running on hardware. These different ways of implementing the functions of the "means for" clauses is recognized in the specification, such as the portion of the specification set forth above, where it states that the controller "includes instructions capable of executing on a processor" and that the controller "may be implemented in hardware". One of ordinary skill in the art recognizes that, especially in view of the disclosure in the specification, that there are a number of different ways that controller may be configured to perform the recited functions. It is also submitted that applicant is not required to limit the controller only to hardware, software, or a combination of the two in order to avoid indefiniteness in the claim.

As to paragraph 10, it is submitted that neither the claim language nor the specification need to specify that the functions of the means claims are performed by only one processor or different processors for each function. While one of ordinary skill in the art recognizes that multiple functions may

Appn. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

be performed by one processor, and indeed the specification states that "controller 171 includes instructions capable of executing on a processor" (emphasis added), it is submitted that the invention is not limited to being performed on one processor, and that the claim does not have to be limited to one processor or multiple processors to avoid indefiniteness.

Withdrawal of the 35 USC 112 (second paragraph) rejection is respectfully requested.

Paragraphs 11 through 23 of the Office Action

Claims 1 through 6 and 23 have been rejected under 35 USC §102(b) as being anticipated by Wyatt (U.S. Patent No. 6,041,411).

Claim 1 requires, in part, "receiving a request from an electronic device for a product code for a previously purchased product, the request including an identification from the electronic device". Support for the amended language of the claim can be found throughout the application, for example, in Figure 2. Similarly, claim 23 requires "means for receiving a request from an electronic device for a product code for a previously purchased product, the request including an identification from the electronic device".

The rejection of the claims relies upon the Wyatt patent, but it is submitted that the system discussed in the Wyatt patent does not disclose the elements of claims 1 and 23, particularly as amended. More specifically, the Wyatt patent discusses a system in which the request transmitted is a request for "one or more software products". See, for example, Wyatt at col. 4, lines 54 through 64:

Step 32 indicates that the server 14 receives the request for one or more software products, and retrieves the requested products. The software products may be stored on the server 14, or may alternatively be downloaded from other computer systems, such as from a plurality of computer systems of software vendors.

Appln. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

It is submitted that one of ordinary skill in the art would not recognize that this request for "one or more software products" as "a request from an electronic device for a product code for a previously purchased product", as required by the language of the claims.

The rejection refers to step 58 shown in Figure 3 of the Wyatt patent, but it is submitted that this portion of the Wyatt patent does not disclose the request as required by the language of the claims. In particular, this aspect of the Wyatt patent discusses payment information that is stored and may be retrieved for making subsequent purchases of software products. See, for example, Wyatt at col. 5, line 64 through col. 6, line 14, where it states (emphasis added):

Decision step 56 determines whether the client computer 12 has been previously registered. If it has not been previously registered, the user enters the registration information (identification and payment information) and the SKU number(s) corresponding to the software products desired, as shown at step 58. If the client computer 12 has been previously registered, only the SKU number(s) need to be entered, as illustrated at step 60. Note that in one embodiment of the invention, identification and payment information is only transmitted once to the server 14, where the information is stored. This information is also stored on the client computer 12, such that at the time of a subsequent purchase, the user again enters this information, but it is not transmitted to the server 14. Instead, the client computer 12 uses the information to verify the user by comparing the stored information to the entered information. The user is allowed to request desired software products only if this information matches.

It is submitted that the transmission of payment information for the purpose of purchasing one or more software products, as is discussed above in the above-noted portion of the Wyatt patent, would not lead one of ordinary skill in the art to the claim requirement of "receiving a request from an electronic device for a product code for a previously purchased product, the request including an identification from the electronic device".

The rejection further points to step 62 of the Wyatt patent, which is

Appn. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

discussed at col. 6, lines 15 through 19, which states (emphasis added):

After the SKU number has been entered at step 60, or the SKU number and registration information at step 58, the client program generates a purchase request message that is transmitted to the server 14 for processing, as illustrated by step 62. The purchase request message is preferably encrypted for system security. The server 14 processes the request at step 64, which includes receiving the request and determining whether the requested software products are available to be transmitted to the client computer 12. Where the purchase request message was transmitted to the server 14 in encrypted form, step 64 further includes decrypting the purchase request message.

It is submitted that the request referred to in this portion of the Wyatt patent is as was described earlier—a request for purchase of software products--and not a request for a product code for a previously purchased product.

It is therefore submitted that the Wyatt patent does not anticipate the requirements of claims 1 and 23, particularly as amended, and that claims 1 and 23, as well as the claims that depend from claims 1 and 23, including claims 2 through 6, are also allowable over the Wyatt patent..

Withdrawal of the 35 USC §1029(b) rejection of claims 1 through 6 and 23 is respectfully requested.

New Claims

Several new claims have been added by this amended, and it is submitted that these claims recite subject matter of the elected invention.

New claim 34 requires “sending the product code and the identification to a server when the product is purchased” and “copying the product code and the identification to a database on the server”. Support for this requirement can be found in the specification and drawings of the application, such as, for example, on page 10 of the specification and Figure 2 of the drawings. It is submitted that this requirement is not disclosed by the Wyatt patent.

Appln. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

New claim 35 requires "retrieving the product code from the server to enable use of the product on the electronic device when the product is reinstalled on the electronic device". This requirement is also supported in the specification at, for example, page 10 and Figure 2. As noted above, the Wyatt patent discusses the initial purchase of software products, and therefore this requirement is submitted to be different from the Wyatt system..

New claim 36 requires "inserting the product code into an installation routine for reinstalling the previously purchased product to enable use of the product on the electronic device", and finds support at similar places in the application. It is submitted that the Wyatt patent does not disclose this requirement..

New claim 37 requires "loading the product onto the electronic device by a manufacturer of the electronic device", "loading the product code for the product onto the electronic device" and "copying the product code and the identification associated with the product code to a database to permit future retrieval of the product code using the identification". These requirements are also supported in the application at least on page 10 and in Figure 2. It is submitted that the discussion in the Wyatt patent would not lead one of ordinary skill in the art to the requirements of this claim, particularly with respect to the actions of the manufacturer.

New claim 38 requires that "the request for the product code is sent by the electronic device during an attempt to install the product on the electronic device", and new claim 39 requires that "the request for the product code is sent by the electronic device as a part of an installation process to install the product on the electronic device". It is submitted that the Wyatt discusses sending a request prior to the purchase of the subject

Appn. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

software product, and therefore is completely different than what is required in this claim.

New claim 40 requires that "the request by the electronic device is transmitted over a network, and the product code is sent over the network to the electronic device". In combination with the requirements of claim 1 regarding the request, it is submitted that the Wyatt patent would not lead one of ordinary skill in the art to this feature of the invention.

New claim 41 requires that "the product was previously loaded on the electronic device making the request, and the request for the product code is made as part of a reinstallation process for the product on the electronic device", and it is submitted that this requirement is contrary to the software purchase system discussed in Wyatt.

New claim 42 requires that "the sending of the product code does not include sending the product for which the product code enables use", which is supported in the application at pages 9 and 10 and the process shown in Figure 2. It is submitted that this is directly contrary to the system discussed in Wyatt for purchasing software.

New claim 43 defines a method comprising:

loading a product onto an electronic device by a manufacturer of the electronic device;

loading the product code for the product onto the electronic device to enable use of the product on the electronic device;

copying the product code and an identification associated with the product code to a database to permit future retrieval of the product code using the identification;

receiving a request from the electronic device for the product code for the product, the request including the identification from the electronic device;

searching the database using the identification to find the product code associated with the identification; and

sending the product code to the electronic device to permit reinstallation of the product on the electronic device utilizing the product code;

Appln. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

wherein the product code enables use of the product on the electronic device, said product not being usable on the electronic device until being enabled with the product code.

It is submitted that the detailed aspects of this claim are not disclosed by Wyatt.

New claim 44 defines an apparatus comprising:

a controller including a processor; and
a storage device, wherein the storage device includes instructions, which when executed on the processor cause the controller to:
receive a request from an electronic device for a product code for a previously purchased product, the request including an identification from the electronic device;
find a product code associated with the identification; and
send the product code to the electronic device;
wherein the product code enables use of a product on the electronic device, said product not being usable on the electronic device until being enabled with the product code.

It is submitted that, at least for the reasons set forth above regarding claim 1, that claim 44 is also allowable over the Wyatt patent:

New claim 45 defines a method comprising:

loading a product onto an electronic device by a manufacturer of the electronic device;
loading the product code for the product onto the electronic device to enable use of the product on the electronic device;
copying the product code and an identification associated with the product code to a database to permit future retrieval of the product code using the identification;
receiving a request for the product code for the product previously loaded on the electronic device, the request including the identification from the electronic device, the request being transmitted during an installation process for the product;
searching the database using the identification to find the product code associated with the identification; and
sending the product code to the electronic device to permit reinstallation of the product on the electronic device utilizing the product code;

Appln. No. 10/625,151
Amendment dated December 15, 2008
Reply to Office Action mailed September 18, 2008

wherein the product code enables use of the product on the electronic device, said product not being usable on the electronic device until being enabled with the product code.

As noted previously, the Wyatt patent discusses transmitting a request prior to the purchase of the software product, and therefore it is submitted that it does not disclose sending the request during an installation of the product.

For the reason above, as well as other, allowance of the new claims is therefore requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

GATEWAY, INC.

By 
Jeffrey A. Proehl (Reg. No. 35,987)
610 Gateway Dr., Y-04
N. Sioux City, SD 57049
Telephone (605) 232-1967
Fax (605) 232-2612

Date: Dec. 15, 2008